REMARKS/ARGUMENTS

Claims 1-31 are pending in this application. Claims 1, 10, 19 and 25 are independent claims. Claims 1 and 10 have been currently amended. Claims 4, 13 and 19-31 are withdrawn from consideration.

Telephone Interview with Examiner

The undersigned Applicants' representative had a telephone interview with Examiner on January 10, 2005. During the interview, Applicants' representative respectfully reminded Examiner that he has failed to indicate the reasons for rejecting Claims 10-12 and 14-18 in the Office Action and that the last name of the first inventor of U.S. Patent 5,974,588 (given at page 4 of the Office Action as prior art) is not Cortopassi as indicated in the Office Action. Examiner notified Applicants' representative that Claims 10-12 and 14-18 were rejected based on the same rationales as applied to Claims 1-3 and 5-9 and that the correct prior art cited should be U.S. Patent No. 5,974,558, not U.S. Patent No. 5,974,588. No agreement has reached regarding allowance of the pending claims.

Election/Restrictions

Applicants herein affirm the previous election of Species I, Claims 1-3, 5-12 and 14-18 and withdraw Claims 4, 13 and 19-31 from further consideration.

Claim Objections

Claim 1 was objected to because of informalities (Office Action, page 3, bottom 3 lines). Applicants have amended the claim in accordance with the Patent Office's suggestion. For the similar reason, Applicants have also amended Claim 10.

Claim Rejections – 35 USC § 103(a)

Claims 1-3, 5-12 and 14-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants Admitted Prior Art (AAPA) in view of Cortopassi et al. ("Cortopassi", U.S. Patent No. 5,974,558). Applicants respectfully traverse this rejection.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent Claim 1 recites an element of "detecting an idle condition of said Serial ATA interface" (emphasis added). In rejecting Claim 1, the Patent Office first admitted that AAPA does not disclose the element (Office Action, page 4). Then, the Patent Office went on to allege that Cortopassi teaches the element (Office Action, page 4). Applicants respectfully disagree. Applicants respectfully submit that the parts of Cortopassi cited by the Patent Office fail to teach, disclose or suggest the element. For example, in Cortopassi, col. 7 lines 23-26 recites "[i]n this state 162, specific inactive devices are each put into a static state after a predetermined time-out period of inactivity for that device", col. 8 lines 10-12 recites "[a]lternatively, the 'sleep' mode may be entered from the active state 161 after a preset period of inactivity", and col. 9 lines 59-65 recites "[u]pon expiration of a timer, the wireless interface device 100 enters into an internal state 'suspend' mode 165. In a suspend mode, the wireless interface device 100 is essentially turned off and communication packets from the host computer 101 are not handled. The wireless interface device 100 emerges from suspend state 165 into active state 161 when a pen event is detected." None of the cited parts of Cortopassi teach, disclose or suggest "detecting" or "idle condition of said ATA interface", *let alone* "detecting an idle condition of said Serial ATA interface," as recited in Claim 1. Applicants herein respectfully request the Patent Office to pinpoint exactly where in Cortopassi is "detecting an idle condition of said Serial ATA interface," as recited in Claim 1, taught, disclosed, or suggested.

Moreover, "to rely on a reference under 35 U.S.C. 103, it must be analogous prior art" (MPEP § 2141.01(a)). Here, the present invention relates particularly to "a method and apparatus of automatic power management control for a Serial ATA interface" (Paragraph [0001], Specification) (emphasis added). In contrast, Cortopassi "relates to a pen-based computer system" (col. 1, lines 51-52). Thus,

Kauffman is clearly nonanalogous art, and thus cannot be relied on to reject Claim 1.

At least based on the foregoing reasons, the rejection of Claim 1 should be withdrawn and Claim 1 should be allowed.

Claims 2-3 and 5-9 depend from Claim 1 and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 2-3 and 5-9 should be allowed.

Claims 10-12 and 14-18 were rejected based on the same rationales as applied to Claims 1-3 and 5-9 (see the foregoing *Telephone Interview with Examiner* part). Thus, Claims 10-12 and 14-18 should be allowed since Claims 1-3 and 5-9 are allowable.

CONCLUSION

In light of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
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Dated: February 10, 2005

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